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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,119	03/14/2001	Daisuke Yano	010324	6260

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EXAMINER

RICKMAN, HOLLY C

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,119

Applicant(s)

YANO ET AL.

Examiner

Holly Rickman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-11 and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The objection to the drawings is withdrawn in view of Applicant's submission of a corrected Figure 4.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et al. (U55972438).

Claim 1 requires a transferable magnetic tape in which a printed layer, a magnetic recording layer, and an adhesive layer are layered in sequence upon a backing film with said printed layer closest to said backing film, wherein said printed layer comprises: a pattern printed region and, a filling layer region outside the pattern printed region, and moreover a thickness of said printed layer is uniform, and in said transferable magnetic tape a coercivity of magnetic powder contained in said magnetic recording layer is 20-320 kA/m.

The examiner notes that "printed in sequence" does not require the recited layers to be in direct contact with one another. For example, a magnetic tape having a printed layer, protective

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layer, magnetic layer, and adhesive layer formed in this order meets applicants requirement that the recited layers be formed in sequence.

Suzuki discloses a magnetic tape comprising a holding material 90 (equivalent to applicants claimed backing material), a peeling layer 91, a protective layer 93, a 2nd magnetic layer 95, a first magnetic layer 96, and an adhesive layer 98 (equivalent to applicants claimed adhesive) formed in this order (see figure 19, and column 12, lines 49-column 13, line 10).

Suzuki discloses that the second magnetic layer can comprise non-erasable and non-alterable coding information, such as a bar code pattern or letters (column 2, lines 60-66). As a bar code pattern or pattern of letters includes a pattern printed region and a filling layer region outside the printed region, the 2nd magnetic layer 95 of Suzuki is considered to be equivalent to applicants claimed printed layer having a pattern printed region and a filling layer region. In specific embodiments, the thickness of the 2nd magnetic layer is disclosed to be 6gm (column 27, lines 20-30).

From this disclosure and from the diagrams, it is apparent that the coating thickness of the second magnetic layer is uniform. Thus, the second magnetic layer of Suzuki meets all of the limitations of the applicant's claimed pattern printed layer. The 1st magnetic layer 96 is comprised of magnetic particles and a binder (column 12, lines 15-25). Suitable magnetic particles include gamma iron oxide (coercivity of 250-400Oe), Cobalt clad gamma iron oxide (coercivity of 600-700Oe), and barium ferrite (coercivity of 1600-1900 Oe or 2500-3000 Oe) (column 12, lines 3-8). As applicants claimed coercivity range of 20-320 kA/m is equivalent to 251-4021 Oe, it is clear that the magnetic particles of Suzuki meet the claimed coercivity range. Thus, the first magnetic layer of Suzuki is equivalent to applicant's claimed magnetic layer

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having a specific coercivity. Finally, it is noted that Suzuki teaches that this magnetic tape forms a magnetic transfer tape (column 29, lines 25-35).

Thus, Suzuki anticipates all of the limitations of claim 1.

Claim 2 requires the patterned printed region and filling layer region to comprise a printing ink. The examiner notes that the term "printing ink," is not defined in the specification or the claims. As it is the examiners duty to give the claims their broadest reasonable interpretation, the examiner interprets the term "printing ink" as being read on by any prior art material that is capable of being printed, i.e. particles in a binder.

Bearing the above interpretation in mind, Suzuki teaches that the magnetic coating is formed by dispersing magnetic particles in a solution of binder and solvent, followed by coating the solution onto the support and drying the solution. The examiner interprets the coating process taught by Suzuki to be equivalent to a printing process. Thus, the examiner interprets the coding layer of Suzuki, which comprises particles in a binder and is applied via a printing process, to be equivalent to applicants claimed "printing ink."

Claim 3 requires a resin layer having peelability to be provided between the backing film and the printed layer. As discussed above for claim 1, Suzuki discloses the use of a peeling film 91 between a holding material 90 and the second magnetic (coating) layer 95. Thus, Suzuki anticipates this limitation.

Claim 12 basically requires the same limitations as claim 1, except that it requires a magnetic card. Suzuki specifically teaches that the transferable magnetic tape is useful for forming a magnetic stripe on a magnetic card (column 1, lines 10-20 and column 17+ "examples"). Thus, Suzuki anticipates the limitations of claim 12.

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Claims 13 and 14 and met as set forth above for claims 12 and 1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-5 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al., as applied above, and further in view of Kubota (US 4132350).

Suzuki as set forth above for claims 1 and 12 does not teach the use of a masking layer between the patterned layer and the magnetic layer as required by claims 4-5 and 15-16.

However, Kubota teaches a magnetic card comprising a card base, a magnetic layer on the substrate, a color layer on the magnetic layer, and a pattern layer on the color layer (column 1, lines 37-42). The patterned layer comprises a pigment in a binder, and forms letters or marks (column 3, line 65-column 4, line 17). The magnetic layer comprises ferromagnetic particles in a binder (column 3, lines 40-50). The color layer comprises a pigment or dye with high hiding power dissolved in a binder (column 3, lines 50-65). By providing the color layer between the magnetic layer and the printed layer, the unattractive color of the magnetic layer is hidden and as a result the appearance of the patterned layer is improved (column 1, lines 25-36).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to place the color layer taught by Kubota between the magnetic layer and the coded layer of Suzuki.

One would have been motivated to make this modification in view of the fact that Suzuki teaches that the appearance of a patterned layer over a magnetic layer is improved by providing a colored layer between the patterned layer and the magnetic layer. One would have been further motivated in view of the fact that the patterned layer of Suzuki forms a pattern of letters, marks, or a bar code over a magnetic recording layer, and so is substantially similar to the patterned layer of Kubota.

The examiner notes that the colored layer of Kubota is considered to be equivalent to applicants claimed masking layer. The colored layer is specifically taught to have "high hiding power" and functions to hide the color of the magnetic layer. This function is equivalent to that of a masking layer.

As set forth above, the combination Suzuki with Kubota meet all of the limitations of claims 4-5 and 15-16.

Response to Arguments

6. Applicant's arguments filed 2/16/05 (supplemental amendment filed 5/19/05 has been entered) have been fully considered but they are not persuasive.

Applicant argues that Suzuki fails to meet all of the limitations of Applicant's claims including a pattern printed region, a non-printed region and a filling layer region as specified in the present application.

The examiner notes that the claims must be assigned the broadest reasonable interpretation allowable within the confines of what is defined in the specification and the prior art. In the instant case, the claims do not recite "a non-printed region." As such, this has no

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bearing on the scope of the claims. The examiner maintains that Suzuki meets the limitations directed to a “pattern printed region” and “filling layer region” for the reasons set forth in the rejection above.

Applicant further argues that the “printing” process taught by Suzuki is not the same as in the present invention. However, the present claims do not limit the particular printing steps used to form the claimed structure.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Holly Rickman", with a stylized flourish at the end.

Holly Rickman
Primary Examiner
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